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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,948	06/01/2006	Nobuyuki Takakuwa	8048-1135	8740
466 7590 02/03/2010 YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314			EXAMINER HUR, ECE	
			ART UNIT 2175	PAPER NUMBER
			NOTIFICATION DATE 02/03/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary

Application No.

10/562,948

Applicant(s)

TAKAKUWA ET AL.

Examiner

ECE HUR

Art Unit

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-7, 10, 15, 26 and 28-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-7, 10, 15, 26 and 28-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/01/2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 1, 2009 has been entered.

This action is responsive to Response/Arguments filed on December 1, 2009 in which Claims 3-7, 10, 15, 26, 28-33 are pending and Claims 3, 4, 6, 7, 10, 15, 26, 28 are currently amended. Claims 31-33 are added as new Claims. This application claims priority from application 2003189821, Japan, filed July 1, 2003.

Status of Claims

Claims 3-7, 10, 15, 26, 28-33 are pending in the case. Claims 28 is the independent Claim.

Claims 1, 2, 8, 9, 11-14, 16-25, 27 have been canceled.

Claims 3-7, 10, 15, 26, 28-33 are rejected under 35 U.S.C. 103(a).

Response to Arguments

Applicant's arguments filed December 1, 2009 have been fully considered but they are not persuasive. See rejection for details. Applicant argued:

Art Unit: 2175

1) Applicant argues that Takahashi does not disclose that information items recorded separately from each other can be correctly joined and continuously reproduced, however Takahashi discloses that video and audio information items are recorded separately from each other and they can be correctly joined and continuously reproduced. (Takahashi, Summary).

2) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

3) Applicant argues that Takahashi and Setogawa do not teach the claimed aspect of entity information, however Setogawa discloses the first stream(video and still picture, object data) and the second stream(menu information, play list information) in FIGs. 3 and 4.

4) Applicant argues about the amended Claim. See rejection for details.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been

Art Unit: 2175

obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3-7, 10, 15, 26, 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Setogawa, EP 0898279 in view of Takahashi, US 5966495.

Regarding Claim 3, most of the limitations have been met in the rejection of Claim 28. See details for Claim 28 rejection. Setogawa discloses the claimed aspect of at least one of the plurality of menu information includes button command (FIG. 3, Scene1, Scene2, and Next Page) information for defining the operation.

Regarding Claim 4, most of the limitations have been met in the rejection of Claim 1. See details for Claim 1 rejection. Setogawa discloses the claimed aspect of at least one of the plurality of menu information includes button control information being associated with at least one button image information which is displayed and outputted as a button menu (FIG. 3, Scene1, Scene2), and for displaying and outputting the button image information (FIG. 3, Scene1 is selected at step image displayed, at step 4 actual replay provided. (FIG. 3, Paragraph 0115).

Regarding Claim 5, most of the limitations have been met in the rejection of Claim 4. See details for Claim 4 rejection. Setogawa discloses the claimed aspect of button control information includes at least one of association information which indicates association with the button image information (FIG. 4, 11 is related to 15 (image) display position information which indicates a display position of a button defined by the button image information (FIG. 4, 15 (image) is related to 22 (Chapter1), and near-by button information which indicates a change in a state of the button caused by the operation, wherein the selection of BTN#1 changes the state of the button. (Setogawa, FIG. 4, Paragraphs 0084-0088).

Regarding Claim 6, most of the limitations have been met in the rejection of Claim 28. See details for Claim 28 rejection. Setogawa discloses the claimed

Art Unit: 2175

aspect of said menu information is displayed, with said menu information superimposed on or in place of one portion of said video information or said still picture information (Setogawa, FIG. 3, 4, Scene1 and Scene2 are on the content information) or is not displayed at all, selectively in accordance with external designation.

Regarding Claim 7, most of the limitations have been met in the rejection of Claim 28. See details for Claim 28 rejection. Setogawa discloses the claimed aspect of said second stream information is recorded together with said first stream (FIG. 10, relationship between button information and content is illustrated), in a content space in which said first is recorded and which occupies one area of a recording area in FIG. 3, 4, 6, 10, 20, wherein menu button is used for replaying information on the recording medium (Setogawa, Paragraphs 0001, 0003).

Regarding Claim 10, most of the limitations have been met in the rejection of Claim 29. See details for Claim 29 rejection. The steps to achieve information recording medium achieves the information recording apparatus. The rejection for Claim 6 applies to Claim 10. See the rejection details for Claim 6.

Regarding Claim 15, most of the limitations have been met in the rejection of Claim 12. See details for Claim 12 rejection. The rejection for Claim 6 applies to Claim 15. See rejection details for Claim 6.

Regarding Claim 16, most of the limitations have been met in the rejection of Claim 12. See details for Claim 12 rejection. Setogawa discloses the claimed aspect of a buffer memory for storing the generated button menu in FIG. 13, wherein display memory 118 and 119 is illustrated. (Setogawa, Column 19, Paragraph 0119).

Regarding Claim 17, the rejection for Claims 1, 3, 4 apply to Claim 17. See the rejection details for Claims 1, 3 and 4.

Regarding claim 26, the rejection of claim 15 applies to claim 26.

Regarding claim 27, the rejection of claim 16 applies to claim 27.

Regarding Claim 28, Setogawa discloses the claimed aspect of an information recording medium on which there are recorded; an object data file for storing a first stream including video information or still picture information and a

Art Unit: 2175

second stream including a plurality of menu information each of which is displayed in response to a user operation and can select a reproduction point of the first stream or a change of reproduction condition of the first stream in response to the user operation(Setogawa, FIG. 3); and a play list information for storing a plurality of item information each of which specifies the first stream by a unit of an item and a plurality of sub item information each of which specifies the second stream by a unit of a sub item, the plurality of item information and the plurality of sub item information being recorded in the play list(Setogawa, FIG. 3, Scene1, Scene2), one menu information of the plurality of menu information specified by the sub item information being superimposed on a display of the first stream during a reproduction of the first stream specified by the item information, the first stream and the second stream being recorded such that the reproduction of the video information or the still picture information included in the first stream which is reproduced before the display of the one menu information is continued, by controlling the first stream and the second stream, during the one menu information is superimposed. (Setogawa, Scene1, Scene2, Next Page, Paragraph 0115, FIGs. 3, 4, 8, 10).

Setogawa does not teach specifically the claimed aspect of the object data file and the play list information being recorded on the information recording medium independently and separately from each other, however Takahashi discloses the claimed aspect, wherein information items which are recorded spatially separately from each other can be correctly joined and continuously reproduced. (Takahashi, Summary).It would be obvious to one of ordinary skill in

Art Unit: 2175

the art at the time of the invention to add this feature to Setogawa's play list because this would allow to play the sound information independently of the still picture.

Regarding Claim 29, the rejection for Claim 28 applies to Claim 29. See Claim 28 rejection for details.

Regarding Claim 30, the rejection for Claim 28 applies to Claim 30. See Claim 28 rejection for details.

Regarding Claim 31, most of the limitations have been met in the rejection of Claim 28. See details for Claim 28 rejection. Setogawa discloses the claimed aspect of an object information file including (i) first address information which includes an address of the first stream (Setogawa, FIGs. 3, 4, 6) which is specified by the item information, and (ii) second address information which includes an address of the second stream (Setogawa, FIGs. 3, 4, 6, Scene 1, Scene 2) which is specified by the sub item information.

Setogawa does not specifically discloses the claimed aspect of the object data file, the play list information and the object information file being recorded on the information recording medium independently and separately from each other, however Takahashi discloses the claimed aspect, wherein information items which are recorded spatially separately from each other can be correctly joined

Art Unit: 2175

and continuously reproduced. (Takahashi, Summary). It would be obvious to one of ordinary skill in the art at the time of the invention to add this feature to Setogawa's play list because this would allow to play the sound information independently of the still picture.

Claims 32, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Setogawa, EP 0898279 in view of Takahashi, US 5966495 in further view of Nonomura, US 5,915,067.

Regarding Claim 32, most of the limitations have been met in the rejection of Claim 28. See details for Claim 28 rejection. Setogawa discloses the claimed aspect of said information recording method records the first stream (Setogawa, FIGs. 3, 4, 6) and the second stream (Setogawa, FIGs. 3, 4, 6, Scene 1, Scene 2), during the one menu information is superimposed. Setogawa does not specifically teach the claimed aspect of the reproduction of the video information or the still picture information included in the first stream which is reproduced before the display of the one menu information is kept, by controlling the first stream and the second stream independently and separately, however Nonomura discloses the claimed aspect in FIG. 20, wherein the first stream is displayed before the second stream. It would be obvious to one of ordinary skill in the art at the time of the invention to display the first stream before the menu information because this would get user's attention.

Regarding Claim 33, most of the limitations have been met in the rejection of Claim 28. See details for Claim 28 rejection. The rejection for Claim 32 applies to Claim 33. See rejection details for Claim 32.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- 1) Nonomura et al., US 6,574,419, 06/03/2003, "Optical disk, reproduction apparatus reproduction method, and recording medium".
- 2) Saeki, et al., EP0886276, 03/1997, "Multimedia optical disc having improved interactive reproduction procedure, a reproduction apparatus and method for such a disc".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ECE HUR whose telephone number is (571) 270-1972. The examiner can normally be reached on Mon-Thurs 7:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM BASHORE can be reached on 571-272-4088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public

Art Unit: 2175

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January 26, 2010
Ece Hur
E.H. /e.h.

/William L. Bashore/

Supervisory Patent Examiner, Art Unit 2175